

REMARKS

The Official Action mailed October 16, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on June 9, 2006, and September 18, 2006.

Claims 1, 2, 4, 6, 8 and 9 were pending in the present application prior to the above amendment. Claims 1 and 2 have been canceled without prejudice or disclaimer. Accordingly, claims 4, 6, 8 and 9 are now pending in the present application, of which claims 4, 6, 8 and 9 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 1, 2, 4, 6, 8 and 9 as obvious based on the combination of U.S. Patent No. 5,550,896 to Chavez and U.S. Patent No. 6,212,390 to Rune. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Independent claim 4 recites search request redirection means that redirects the search request from the authentication controller to a directory server located above or below in the directory information tree among the directory servers corresponding to other sites when the identification information on the mobile communication terminal is not detected by the identification information detection means. Independent claim 6 recites search request transmission means that transmits a predetermined search request to another server apparatus located above or below in the directory information tree when the identification information on the mobile communication terminal is not detected by the identification information detection means. Independent claims 8 and 9 recite a search request transmission step for transmitting a predetermined search request to another server apparatus located above or below in the directory information tree when the identification information on the mobile communication terminal is not detected at the identification information detection step. For the reasons provided below, Chavez and Rune, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

In the Official Action, the recitations of the claims appear to be copied verbatim into the Official Action with brief citations to Chavez allegedly in support of the rejections. These brief citations cite various disclosures in Chavez. However, no reasoning is provided explaining why the citations from Chavez are believed to disclose the claimed features of the present invention, nor are the citations matched to the features of the claims.

The Applicant respectfully submits that Chavez and Rune, either alone or in combination, do not teach or suggest the above-referenced features of independent claims 4, 6, 8 and 9.

Since Chavez and Rune do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Further, the Applicant notes that each of the present independent claims 4, 6, 8 and 9 has a scope equal to or narrower than the scope of each of the allowed claims in the corresponding Japanese Patent Application No. 2004-023384, now Japanese Patent No. 4378182 issued December 2, 2009. Therefore, the Applicant respectfully submits that the allowability of the claims in the Japanese application is a further indication of the patentability of the present claims.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c) and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789